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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,985	12/05/2001	Michael J. Walsh	040014-0101	1944

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777 EAST WISCONSIN AVENUE
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MILWAUKEE, WI 53202-5308

EXAMINER

NICOLAS, FREDERICK C

ART UNIT	PAPER NUMBER
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3754

13

DATE MAILED: 06/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/006,985	WALSH ET AL.
	Examiner	Art Unit
	Frederick C. Nicolas	3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 28 April 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-35 is/are pending in the application.

4a) Of the above claim(s) 4-6, 12, 24 and 27-35 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3, 7-11, 13-23, 25 and 26 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.

4) Interview Summary (PTO-413) Paper No(s). _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species A, Figures 1-5,17-18, claims 1-11,13-23 and 25-26 in Paper No. 11 is acknowledged. Further, claims 4-6 are withdrawn from consideration and added to the non-elected claims above, because the claimed subject matter of claim 4, "further comprising an opening into the body disposed adjacent the spout and sized to permit entry of at least a two inch brush into the container" directed toward a non-elected species.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed subject matter "the spout is sized to permit entry of at least a two inch brush into the container" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2,7,20-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Barker et al. 4,550,862.

Barker et al. discloses a product container 12, which comprises a body 74 having a bottom, a plurality of side walls, and a top 72 as seen in Figure 2 and it is inherent that the container of Barker et al. has a bottom in as much as the applicant's claimed invention, an attachment mechanism 58 located proximate the top, a cap 16 is configured to be secured to the attachment mechanism, a spout 52 is extending upward proximate the top and at least partially surrounded by the attachment mechanism as seen in Figure 2, a channel is located between the attachment mechanism and the spout (col. 4, ll. 25-37), wherein the product spilled into the channel flows back into the container as seen in Figure 6, an opening 54 adjacent the channel, a handle 74a.

Applicants should note that statements of Intended use (preamble), i.e., "a paint container", has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

As above, alternatively, it would have been obvious to a person having ordinary skill in the art to employ paint as the material being dispensed.

5. Claims 9,11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelsey 5,269,438.

Kelsey discloses a stackable plastic paint container (col. 2, ll. 31-37), which comprises a body 2 having a bottom as seen in Figure 5, a plurality of side walls (col. 1, ll. 53-59), a top 3, a spout 9 extends from the top, the bottom is molded in a convex shape as seen in Figure 5, such that the bottom is configured to receive the top of a second paint container (col. 2, ll. 31-37).

6. Claims 9,11,14-20,23 and 25-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Nottingham et al. US 2002/0195471.

Nottingham et al. discloses a stackable plastic paint container 50, which comprises a body 51, a bottom 52, a plurality of side walls 54, a top 86, a spout 160 extends from the top as seen in Figure 1, the bottom is molded in a convex shape as seen in Figure 24, such that the bottom is configured to receive the top of a second paint container as seen in Figure 24, a cap 100, a handle 84; a second handle 120.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3,7,20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barker et al. 4,550,862 in view of Armstrong 4,927,046.

Barker et al. discloses a product container 12, which comprises a body 74 having a bottom, a plurality of side walls, and a top 72 as seen in Figure 2 and it is inherent that the container of Barker et al. has a bottom in as much as the applicant's claimed invention, an attachment mechanism 58 located proximate the top, a cap 16 is configured to be secured to the attachment mechanism, a spout 52 is extending upward proximate the top and at least partially surrounded by the attachment mechanism as seen in Figure 2, a channel is located between the attachment mechanism and the spout (col. 4, ll. 25-37), wherein the product spilled into the channel flows back into the container as seen in Figure 6, an opening 54 adjacent the channel, a handle 74a. Barker et al. lacks the container being a paint container. Armstrong teaches the use of providing a liquid paint container (col. 3, ll. 55-63), the paint container has a pouring spout 3, at least a two inch paint brush (col. 4, ll. 12-15), where the spout is sized to permit entry of the at least the two inch paint brush as seen in Figure 1.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the product of Barker et al. with Armstrong's liquid paint, in order to provide a hand-held vessel for holding paint, as taught by Armstrong (col. 1, ll. 4-5).

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the spout of Barker et al. as such, in order to provide a hand-held vessel for holding paint and paint brush, as taught by Armstrong (col. 1, ll. 10-14).

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barker et al. 4,550,862 in view of Armstrong 4,927,046 as applied to claim 1 above, and further in view of Leiter 4,771,501.

Barker et al.-Armstrong combination has all the features of the claimed invention except that the paint container further comprising a second handle attached to the top. Nottingham et al. shows a paint container 50 with a top 86, the paint container has a first handle 84, a second handle 120, where the second handle is attached at the top of the container as seen in Figure 13.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the second handle of Nottingham et al. onto the top portion of Barker et al. as such, in order to provide a second means of lifting the paint container, as taught by Nottingham et al. (col. 5, ll. 2-4).

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barker et al. 4,550,862 in view of Nottingham et al. US 2002/0195471.

Barker et al. has all the features of the claimed invention except that the paint container further comprising a second handle attached to the top. Nottingham et al. shows a paint container 50 with a top 86, the paint container has a first handle 84, a second handle 120, where the second handle is attached at the top of the container as seen in Figure 13.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the second handle of Nottingham et al. onto the top

portion of Barker et al. as such, in order to provide a second means of lifting the paint container, as taught by Nottingham et al. (col. 5, ll. 2-4).

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelsey 5,269,438 in view of DeJean 4,911,319.

Kelsey has all the features of the claimed invention except that the paint container further comprising a splash guard disposed proximate the spout. DeJean shows a paint container 46 having a spout 14, and a splash guard 44 is disposed proximate the spout as seen in Figure 4.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kelsey's spout by providing DeJean's splash guard onto/proximate Kelsey's spout as such, in order to prevent spillage while pouring as taught by DeJean (col. 3, ll. 34-35).

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nottingham et al. US 2002/0195471 in view of Bolton et al. 5,078,289.

Nottingham et al. has all the features of the claimed invention except that the cap is sized to function as a paint holder. Bolton et al. teaches the use of a cap 12 for a flowable product container 10, where the cap is sized to function as the product holder as seen in Figure 9.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teaching Bolton et al. onto the cap of Nottingham et al. as such, in order to utilize the cap as a product holder so that when an unused

previously poured portion is returned from the cap back into the container, as taught by Bolton et al. (col. 3, ll. 6-9).

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nottingham et al. US 2002/0195471 in view of DeJean 4,911,319.

Nottingham et al. has all the features of the claimed invention except that the paint container further comprising a splash guard disposed proximate the spout. DeJean shows a paint container 46 having a spout 14, and a splash guard 44 is disposed proximate the spout as seen in Figure 4.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the spout of Nottingham et al. by providing DeJean's splash guard onto/proximate Nottingham et al. as such, in order to prevent spillage while pouring as taught by DeJean (col. 3, ll. 34-35).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hall et al. 5,316,054, Renfrew 5,472,111, Henningen 3,590,416, Malvasio 6,138,963, Walsh et al. D 474,115 and Petry 5,709,314 disclose other types of paint container.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick C. Nicolas whose telephone number is (703)-305-6385. The examiner can normally be reached on Monday - Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mancene L. Gene, can be reached on (703)-308-2696. The fax phone number for the organization where this application or proceeding is assigned is (703)-872-9302 and for after final communication is (703)-872-9303.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0861.

FN
June 4, 2003

(P.R) 6/4/03


Gene Mancene
Supervisory Patent Examiner
Group 3700